

REMARKS

This paper is in response to the Office action mailed December 17, 2009 (“the Office Action”). No claims are amended. Claims 1-30 remain pending, of which claims 1, 14, and 25 are independent. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner’s convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants’ understanding and discussion of any reference is consistent with Examiner’s understanding.

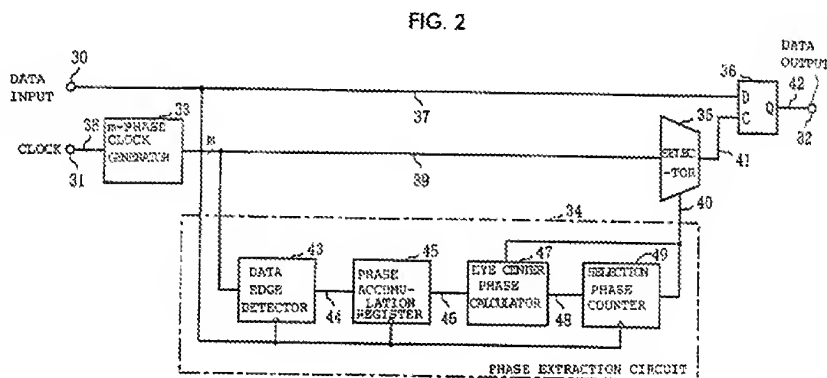
Unless otherwise explicitly stated, the term “Applicants” is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

I. Rejection Under 35 U.S.C. §102

The Office Action rejects claims 1, 5-7, 13, 14, and 18-20 under 35 U.S.C. §102(b) over *Baba et al.* (U.S. Patent No. 6,278,755). According to MPEP §2131, a claim is anticipated under 35 U.S.C. §102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. The reference must show the identical invention in as complete detail as is contained in the claim. Finally, the elements must be arranged or combined as required by the claim.

A. Independent Claim 1

In rejecting independent claim 1, the Examiner characterized *Baba* as teaching a “plurality of circuit elements” (elements “43, 45, 47, 49, etc” in Figure 2 of *Baba*) and a “selector” (selector 35 in Figure 2 of *Baba*). See *Office Action* at 3 and 4. However, as evident from Figure 2 below, selector (35) of *Baba* is not “coupled to [elements 43, 45, 47, 49, etc] for receiving each of the individual output data signals from [elements 43, 45, 47, 49, etc]...” as claimed. (Emphases added.)



In the Response to Arguments section, the Examiner noted that “coupled is defined as bring (circuit components) close enough to permit an exchange of electromagnetic energy. Therefore, selector 35 is coupled to element circuits 43,45,47,59 grouped as 34 and element 33.” See *Office Action* at 2. However, the Examiner has not established, beyond mere conjecture, that selector (35) is “close enough” to elements (43), (45), and (47) “to permit an exchange of electromagnetic energy.” Therefore, the Examiner has not established, beyond mere conjecture, that selector (35) is “coupled to [elements 43, 45, 47, 49, etc] for receiving each of the individual output data signals from [elements 43, 45, 47, 49, etc]...” as claimed.

Moreover, in the Response to Arguments section the Examiner alleged that a clock generator (33) corresponds to one of the claimed “plurality of circuit elements.” See *Office Action* at 2 (“Furthermore, *Baba* discloses the structure of the claimed invention such as a plurality of circuit elements (34, 33)...”). However, the Examiner later alleged that clock generator (33) corresponds to the claimed “second clock signal.” See *Office Action* at 4. Clock

generator (33) cannot possibly correspond to both the “plurality of circuit elements” and the “second clock signal” because claim 1 recites that the second clock signal is “received from a source other than one of the plurality of circuit elements.” (Emphasis added.)

The Examiner also erred in not giving patentable weight to the following limitation of claim 1: “a selector...for sequentially selecting each of said individual data signals to generate [an] output data stream.”

As noted above, the Examiner identified selector (35) as the claimed “selector.” In addition, the Examiner identified data signals output by elements (43), (45), (47), and (49) of *Baba* as the claimed “each of said individual data signals.” See *Office Action* at 3 and 4. Although selector (35) receives a signal output by element (49)—i.e., extracted phase value (40)—this signal is not selected as an output of selector (35). Instead extracted phase value (40) controls which of the m-phase clock signals (39) produced by m-phase clock generator (33) is selected as an extracted clock. See *Baba* at col. 8, lines 23-27 (“The selector 35...alternatively selects an extracted clock 41 from the m-phase clock signals 39 based on the extracted phase value 40.”)

According to the Examiner, “*Baba* discloses the structure of the claimed invention such as a plurality of circuit elements (34, 33) a selector (35) etc....when the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent.” See *Office Action* at 2 and 9 (citing MPEP § 2112.01). *In re Skinner* however, makes clear that the foregoing standard is only applicable after the Examiner has provided “some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that [a] functional limitation is an inherent characteristic of the prior art.” See 2 USPQ2D 1788, 1789 (BPAI 1986) (emphasis added). Moreover, the MPEP requires Examiners to evaluate and consider functional limitations “just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” MPEP § 2173.05(g).

In the present case, the Examiner has advanced no “evidence or scientific reasoning” in support of the belief that the selector (35) of *Baba* inherently performs the function of “sequentially selecting each of [the signals output by elements (43), (45), (47), and (49)] to generate [an] output data stream,” as required by claims 1 and 25. Instead, the Examiner appears to have concluded that selector (35) inherently performs a sequential selection of each of the

signals output by elements (43), (45), (47), and (49) based on the mere fact that selector (35) receives an output from the group of elements (43), (45), (47), and (49). This alone is not sufficient to establish the reasonableness of a belief that the selector (35) inherently performs the claimed function of “sequentially selecting each of [the signals output by elements (43), (45), (47), and (49)] to generate [an] output data stream.” In fact, selector (35) instead uses a single output from the group of elements (43), (45), (47), and (49) to determine which of the m-phase clock signals (39) from m-phase clock generator (33) to select as an extracted clock. *See Baba* at col. 8, lines 23-27. In light of the foregoing, the Examiner’s conclusion of inherency is unreasonable and the Examiner’s failure to give patentable weight to “a selector...for sequentially selecting each of said individual data signals to generate [an] output data stream” constitutes clear error.

In light of the foregoing, Applicants respectfully submit that *Baba* does not anticipate claim 1. Accordingly, the anticipation rejection of claim 1, and of its corresponding dependent claims, should be withdrawn.

B. Independent Claim 14

The Examiner has not established that *Baba* describes the following limitation of claim 14: “clocking said selector with said second clock to sequentially select a plurality of said data signals that are received as input for the selector for said output data stream...”

As with claim 1, the Examiner identified selector (35) as the claimed “selector” and identified data signals output by elements (43), (45), (47), and (49) of *Baba* as the claimed “plurality of said data signals.” *See Office Action* at 6. Although selector (35) receives a signal output by element (49)—i.e., extracted phase value (40)—this signal is not selected as an output of selector (35). Instead extracted phase value (40) controls which of the m-phase clock signals (39) produced by m-phase clock generator (33) is selected as an extracted clock. *See Baba* at col. 8, lines 23-27 (“The selector 35...alternatively selects an extracted clock 41 from the m-phase clock signals 39 based on the extracted phase value 40.”)

In rejecting claim 14, the Examiner also alleged that “Baba discloses the structure of the claimed invention such as a plurality of circuit elements (34, 33) a selector (35) etc....when the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent.” *See Office Action* at 6 and 7 (citing MPEP §

2112.01). However, MPEP § 2112.01 is addressed to “product and apparatus claims” only, not method claims. MPEP § 2112.01 is therefore inapplicable to method claims, such as claim 14.

In light of the foregoing, Applicants respectfully submit that *Baba* does not anticipate claim 14. Accordingly, the anticipation rejection of claim 14, and of its corresponding dependent claims, should be withdrawn.

II. Rejection Under 35 U.S.C. §103

The Examiner rejected claims 2-4, 15-17, 25-27, and 30 under 35 U.S.C §103(a) as being unpatentable over *Baba* in view of *Chen* (U.S. Patent No. 5,850,422) and rejected claims 8-12, 21-24, and 28-29 under 35 U.S.C §103(a) as being unpatentable over *Baba* in view of *Chen*, as applied above, and in further view of *Song* (U.S. Patent No. 6,917,660). Applicants respectfully traverse the rejection.

To support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered.” Further, the Board of Patent Appeal and Interferences recently confirmed that a proper, post-KSR obviousness determination requires “a searching comparison of the claimed invention—including all its limitations—with the teaching of the prior art.” *In re Wada and Murphy*, Appeal 2007-3733 (BPAI 2008), citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Moreover, as the Supreme Court recently stated, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

A. Claims Dependent from Claims 1 and 14

Applicants note that by virtue of their dependence from one of claims 1 and 14, each of dependent claims 2-4, 8-12, 15-17, and 21-24 requires all the elements of one of those independent claims. As noted herein, however, the Examiner has not shown that *Baba* teaches or suggests all the elements of claims 1 and 14. *Chen* and *Song*, relied on for their teachings relative to certain dependent claim limitations, fail to cure the deficiencies of *Baba* with respect to claims 1 and 14. Applicants thus respectfully submit that the rejection of claims 2-4, 8-12, 15-17, and 21-24 should be withdrawn.

B. Independent Claim 25

Claim 25, although of different scope, recites language similar to that of claim 1 discussed above. For example, claim 25 recites a system for multiplexing a plurality of data signals into an output data stream comprising, among other things, “a selector coupled to [a] plurality of circuit elements for receiving each of the individual output data signals from [a] plurality of circuit elements and for sequentially selecting each of said individual data signals to generate said output data stream as the output of the selector.” Moreover, in addressing the foregoing elements of claim 25, the Examiner applied the same arguments used to reject claim 1. Therefore, for at least the reasons discussed above with respect to claim 1, Applicants submit that *Baba* does not teach or suggest the foregoing limitations of claim 25. *Chen*, relied on for its purported teaching of a compensator, fails to remedy the deficiencies of *Baba*.

In light of the foregoing, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to claim 25. Accordingly, the rejection of claim 25, and of its corresponding dependent claims, should be withdrawn.

III. Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 17th day of February 2010.

Respectfully submitted,

/Ronald J. Ward/Reg. No. 54,870

RONALD J. WARD

Registration No. 54,870

Attorneys for Applicant

Customer No. 022913

Telephone: (801) 533-9800

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